

Application no.: 10/027,723
Amdt date: July 15, 2004
Reply to Office Action of April 15, 2004

REMARKS / ARGUMENT

A. INTRODUCTION

Claims 1-18 were examined in the office action having a mailing date of April 15, 2004.

In that office action, the Examiner:

rejected Claims 1-5 under 35 USC §102(e) as being anticipated by US Patent No. 6,161,144 to Michels (hereinafter "*Michels*"); and
allowed Claims 6-18.

B. REJECTIONS UNDER 35 USC §102(e)

Applicant respectfully asserts that 35 U.S.C. § 103(c) applies in this case and may be asserted to overcome the 102(e) rejection. 35 U.S.C. § 103(c) states in part that "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Applicant respectfully asserts Packet Engines Incorporated owned the cited art, *Michels*, and the present invention at the time the present invention was developed. The declarations of Greg W. Davis dated July 13, 2004 and Jayasenan Sundara Ganesh dated June 6, 2004, enclosed and incorporated by reference state Davis and Ganesh were joint inventors of the disclosed invention, which was developed and tested from August 1997 to June 1999 at Packet Engines Incorporated with each inventor having an obligation to assign his inventions to Packet Engines Incorporated. The declarations further state *Michels* was filed on October 5, 1998 and was invented by employees of Packet Engines Incorporated with each inventor having an obligation to assign his inventions to Packet Engines Incorporated. Davis is a named inventor listed as one of the inventors of *Michels*

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as well as the present invention as claimed. Since Packet Engine Incorporated held the obligation of assignment for both *Michels* and the present invention at the time the present invention was made, patentability therefore should not be precluded under 35 U.S.C. § 102(e) (35 U.S.C. § 103(c)). Accordingly, claims 1-5 are presently allowable.

C. AMENDMENT TO CLAIM 6

Claim 6 has been amended to clarify the step of receiving, on a first port, a network address including a source address and a destination address.

D. CONCLUSION

Applicant submits that the present application is in condition for allowance and respectfully requests that a timely Notice of Allowance be issued in this case.

Authorization is given by the undersigned to charge this fee to deposit account number 02-3979. Should there be any additional fees for this response your office is authorized to draw from this same deposit account. In addition, should you have any questions, or identify any problem, the undersigned would appreciate a telephone call so that this matter may be resolved promptly.

Respectfully submitted,

Michael Blaine Brooks, P.C.

By: 

Michael B. Brooks
Reg. No. 39,921
5010 N. Pkwy Calabasas, STE 104
Calabasas, CA 91302-3913
Tel.: (818) 225-2920

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APPENDIX

1. Declaration of Greg W. Davis
2. Declaration of Jayasenan Sundara Ganesh

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Application no. : 10/027,723
Applicant : Jayasenan Sundara Ganesh, et al.
Title : NETWORK SWITCHING DEVICE WITH FORWARDING DATABASE TABLES
POPULATED BASED ON USE
Filed : December 20, 2001
Art Unit : 2667
Examiner : QURESHI, AFSAR M.
Docket no. : 47558/JEC/X2/132311
Customer no. : 35114
Confirmation No. : 9775

JUL 15 2004

OFFICIAL

Date: July 13, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Declaration Under 37 CFR §1.132

I, Greg W. Davis, of Spokane, WA, hereby declare that:

1. I am a joint inventor of the subject matter of the above-identified application.
2. The present Application Serial No. 10/027,723, was conceived on 3/97, submitted as in invention disclosure to Packet Engines Incorporated on _____, developed and tested from 8/97 to 6/99.
3. The present Application Serial No. 10/027,723 is a continuation of Application Serial No. 09/166,604 filed October 5, 1998, and was invented by employees of Packet Engines Incorporated; each inventor-employee having an obligation to assign his inventions to Packet Engines Incorporated.
4. The assignment of Application Serial No. 09/166,604 to Packet Engines Incorporated was recorded in the Assignment Division of the Patent and Trademark Office on October 28, 1998, on reel 9581, frame 0803.
5. The cited reference, US Patent No. 6,161, 144, was filed October 5, 1998, claiming the benefit of Provisional Patent Application No. 60/072,280, filed January 23, 1998, and was invented by employees of Packet Engines Incorporated; each inventor-employee having an obligation to assign his inventions to Packet Engines Incorporated.
6. The assignment of US Patent No. 6,161, 144 (Serial No. 09/166,707) to Packet Engines Incorporated was recorded in the Assignment Division of the Patent and Trademark Office on October 28, 1998, on reel 9581, frame 0813.

Page 1 of 7

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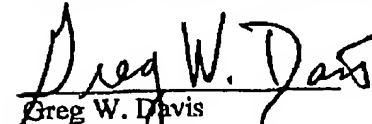
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Application no. 09/992,941
Declaration under 37 CFR §1.132

7. At the time the claimed invention disclosed in the parent application, Application Serial No. 09/166,604, was made, the inventor-employees of the claimed invention of parent application were each subject to an obligation of assignment to the same person, i.e., Packet Engines Incorporated, as the inventors of the cited reference, US Patent No. 6,161, 144.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 USC §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed this 13th day of July, 2004.


Greg W. Davis

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IKANDS COMMUNICATION

PAGE 02/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant : Jayasenan Sundara Ganesh, et al.
Title : NETWORK SWITCHING DEVICE WITH FORWARDING DATABASE TABLES
POPULATED BASED ON USE
Filed : December 20, 2001
Art Unit : 2667
Examiner : QURESHI, AFSAR M.
Docket no. : 47558/JEC/X2/132311
Customer no. : 35114
Confirmation No. : 9775

Date: July 6th, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Declaration Under 37 CFR §1.132

I, Jayasenan Sundara Ganesh, of Cupertino, CA, hereby declare that:

1. I am a joint inventor of the subject matter of the above-identified application.
2. The present Application Serial No. 10/027,723, was conceived on 3/97, submitted as in invention disclosure to Packet Engines Incorporated on _____, developed and tested from 8/97 to 6/99.
3. The present Application Serial No. 10/027,723 is a continuation of Application Serial No. 09/166,604 filed October 5, 1998, and was invented by employees of Packet Engines Incorporated; each inventor-employee having an obligation to assign his inventions to Packet Engines Incorporated.
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IKANOS COMMUNICATION

PAGE 03/03

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Declaration under 37 CFR §1.132

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I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 USC §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed this 6th day of July 2004.


Jayasenan Sundara Ganesh